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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/744,484      | 05/21/2001  | Horst Grafe          | HM-390PCT           | 5641             |

7590

09/22/2004

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| EXAMINER |
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PRONE, JASON D

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| ART UNIT | PAPER NUMBER |
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3724

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,484

Applicant(s)

GRAFE ET AL. *GA*

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration:  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 21 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

With the possibility of allowance, as noted in the previous office action, non-elected claims 7 and 8 have been rejoined with the elected claims so that any issues may be corrected at the same time as the issues list below to prevent any additional office actions.

#### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “recesses 39 and 39”, of claim 7, and the “coupling sockets 40 and 40”, of claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: On page 15, line 5, items "39 and 39'". On page 15 line 6, items "40 and 40'". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description. Their presence in the "List of Reference Numerals" does not satisfy this requirement: In Figure 2, items "25'" and "26". In Figure 3, items "25'", "26", "26'", "37", "37'", "38", and "38'". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In reference to paragraphs 2 and 3 of this office action, that, for example, if applicant decides to just delete item "39" from the specification and to delete item "26" from Figure 3, the drawings would then be objected to under 37 CFR 1.83(a) due to the fact that item "39" is present in claim 7 and item "26" is present in claim 6.

#### ***Specification***

4. The disclosure is objected to because of the following informalities: On page 13 line 25, the phrase "actuating members 11, 25, 30, 36" should be replaced with "actuating members 11, 25, 25', 30, 36, 36'". On page 14 line 24, the phrase "spindle drive 31" should be replaced with "spindle drive 31, 31'". On page 17, the phrase "2, 2' rolling table" should be separated into "2 rolling table" and "2' movable part". On page 17, the phrase "8' gear" should be replaced with "8' reducing gear". On page 18, the phrase "31 spindle drive" should be replaced with "31, 31' spindle drive". In the "List of Reference Numerals" items "39, 39'" and "40, 40'" were previously deleted by amendment, but these reference numbers appear on lines 5 and 6 on page 15 respectively.

Appropriate correction is required.

***Claim Objections***

5. Claims 6 and 7 are objected to because of the following informalities: On lines 2 and 8 respectively, the phrase "the holding element (6)" should be replaced with "the holding element (6, 6`)" as shown on line 4 of claim 4.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

8. On page 13 lines 24-25, the phrase "As also illustrated in Fig. 1, at the rolling table side at least one clamping element 7 with actuating members 11, 25, 30, 36" is unclear. First, actuating member does not have a corresponding clamp member 7 as shown in Figure 4. Second, the phrase makes reference to Fig. 1 but actuating members 30 and 36 are only in Figure 4 and Figures 5 and 6 respectively. It is unclear how actuating members 30 and 36 are incorporated into Figures 1-3.

9. On page 15 lines 1-2, the phrase "The coupling rods 32, 32' can be engaged via lower recesses 27, 27' by congruent coupling sockets 28, 28'" is unclear. Using Figure 4, it is clear that the oblique rods are the coupling rods 32, 32'. However, it appears

that 27, 27' is just pointing at the coupling rod; it is uncertain how this is considered a recess. It also appears that 28, 28' is pointing to the exact same spot that 27, 27' is pointing at. It is uncertain how this is considered a coupling socket when it is pointing at either the recess or the coupling rod.

10. In regards to reference number 21 (Coupling elements), there is no description in specification of how 21 works or how 21 interacts with clamp 7 or holding elements 6, 6'. Therefore it is unclear how 21 acts as a coupling element.

11. In regards to reference numbers 26, 26' (guiding path), there is no description in specification of how 26 works or what function 26 it performs. Therefore, it is unclear how 26, 26' act as a guiding path.

12. In regards to page 15 lines 23-24, the phrases "lower pressure plates 23, 23'" and "glide plates 24, 24'" are a description of how these items work in the embodiment shown in Figures 5 and 6. Therefore, there is no disclosure of how "lower pressure plates 23, 23'" and "glide plates 24, 24'" work in the embodiment shown in Figures 1-3. It is unclear how items 23 and 24 interact in regard to the first embodiment of Figure 2.

13. In regards to reference numbers 37, 37' (pressure plates) and 38, 38' (gliding plates), there is no description in specification of how 37, 37' and 38, 38' work or what function 37, 37' and 38, 38' performs. Therefore, it is unclear how 37, 37' act as pressure plates and how 38, 38' act as gliding plates.

14. In regards to page 15 lines 17-19, the phrase "With the aid of the force means 36, 36', the clamping element 7 is folded upwardly" is unclear. It is uncertain what

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structure incorporated by 36, 36` allows the clamping element to be folded. Basically how does the force means aid the clamp.

15. In regards to reference numbers 25, 25`, it is unclear what these actuating members/force means perform a function on. It is unclear if they actuate/force the clamp or if the actuate/force the movable part.

16. In regards to the moving of the shears, it is clear that, along with the shears, the holding elements 5, 5` and the arms 22, 29 must move as well, however it is unclear what/if any other portions move as well. For example, it is uncertain if the holding elements 6, 6` move with the shears or remain stationary. If this is the case, it is unclear what structure allows the holding elements 6, 6` to move.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

19. In regards to claim 1, the phrases "wherein the shears (3) can be moved together with the blade holders (4, 4`) and with their holding elements (5, 5`; 6, 6`)" and "a forward connection between the blade holders (4, 4`) or between the holding elements (6, 6`) are unclear. It is uncertain what structure travels with the moving shears 3 and the blade holders 4, 4`. The second phrase listed above leads one to believe that the holding elements 6, 6` can travel with the shears or remain stationary. It is unclear what



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structure would allow the holding elements 6, 6' to remain stationary or what structure would allow them to move.

20. In regards to claim 1, the phrase "a clamping element (7 or 32)" is unclear. It is uncertain what structure allows item "32" to be considered a clamping element.

21. Claim 2 recites the limitation "the blade holders (4, 4')" on lines 13-14. There is insufficient antecedent basis for this limitation in the claim.

22. In regards to claim 3, the phrase "clamping member (7) with actuating members (11, 25, 30, 36) is unclear. It is uncertain how clamp 7 interacts with actuating member 30, since actuating member 30 only interacts with coupling rods (32).

23. In regards to claim 5, the phrase "the clamping member (7) coupling together the holding element (6, 6')" is unclear. It is uncertain how the clamp couples together the holding element.

24. In regards to claim 5, the phrase "coupling elements (21)" is unclear. It is unclear how the coupling elements perform any function.

25. In regards to claim 6, the phrase "guiding plates 38, 38'" is unclear. It is not certain how the guiding plates perform any function.

26. In regards to claim 6, the phrase "guiding path 26, 26'" is unclear. It is not certain how the guiding paths perform any function.

27. In regards to claim 7, the phrase "recesses (27, 27' and 39, 39')" is unclear. It is uncertain what structure allows 27, 27' to be considered a recess. From the Figure 4, 27 appears to be a lower section of coupling rod and the specification does not provide

any information to believe otherwise. It is unclear what structure recesses 39, 39' incorporate and where they are located.

28. In regards to claim 6, the phrase "congruent coupling sockets (40, 40') are unclear. It is uncertain what structure the congruent coupling sockets 40, 40' incorporate and where they are located.

29. In regards to claim 8, the phrase "the aid of at least one force means (36) for coupling of the two frame arms" is unclear. It is unclear what structure allows the force means (36) to aid the joint (34).

#### ***Response to Arguments***

30. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Allowable Subject Matter***

31. Claims 1-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP  
September 14, 2004



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